



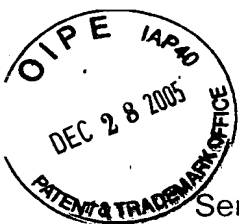
Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)
Approved for use through xx/xx/200x. OMB 0651-00xx
U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE
Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

| PRE-APPEAL BRIEF REQUEST FOR REVIEW | | Docket Number (Optional) ASA-520-03 | |
|--|--|--|--|
| I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on _____ Signature _____ Typed or printed name _____ | Application Number 09/836,299 | Filed April 18, 2001 | |
| | First Named Inventor N. IWAMI et al | | |
| | Art Unit 2666 | Examiner D.T. Ton | |
| <p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input checked="" type="checkbox"/> attorney or agent of record. 34,663 Registration number _____</p> <p><input type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34 _____</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> | | | |
| <p><input type="checkbox"/> *Total of _____ forms are submitted.</p> | | | |

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.



Serial No. 09/836,299

ASA-520-03

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appl. No. : 09/836,299 Confirmation No. 7838
Applicant : N. IWAMI et al
Filed : April 18, 2001
Titled : VOICE COMMUNICATION SYSTEM AND VOICE
COMMUNICATION METHOD
TC/A.U. : 2666
Examiner : D.T. Ton
Docket No. : ASA-520-03
Customer No.: 24956

Commissioner for Patents
MAIL STOP: AF
P.O. Box 1450
Alexandria, VA 22313-1450

December 28, 2005

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Sir:

In a final Office Action mailed September 16, 2005, the Examiner has rejected claims 23, 25-26, 28-30, 32-33 and 35-36 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-4 of U.S. Patent No. 5,604,737. This is the only grounds of rejection contained in the final rejection. Since Applicants believe that there is a clear deficiency in the *prima facie* case in support of the Examiner's rejection, this request is being filed in order to avoid

the lengthy appeal process. The following is an explanation of Applicants' position that the Examiner's rejection is clearly deficient.

In the Office Action on page 8, numbered paragraph 3, the Examiner states that Applicant traverses this rejection on the ground that the claims of the patent do not teach a first unit and a second unit. The Examiner then states that he is interpreting the means for transmitting as the second unit and the means for receiving as the first unit, in claim 1 of U.S. Patent No. 5,604,737 (the '737 patent). Applicants wish to clarify that the double patenting rejection was traversed by the following statements contained on page 9 of the response filed June 27, 2005, under the "Double Patenting Rejection" section. In particular, Applicants stated the following:

The pending claims, as amended, are directed to a communications server having structural and functional limitations that are not obvious in view of the claims of U.S. Patent No. 5,604,737. This functional language describes the elements that perform a process between the communication terminal and the telephone, particularly for the communications started by the communication terminal (first terminal) to call the telephone (second terminal), as shown in Fig. 11. As such, it is submitted that the double patenting rejection has been overcome.

Additional arguments were presented in the paragraph bridging pages 9 and 10 of the response filed June 27, 2005. These arguments are incorporated by reference.

Further to the arguments presented above, Applicants provide the following arguments as to why the double patenting rejection cannot be supported by the facts. Claims 1-4 of the '737 patent recite elements of a voice communication system but do not recite the functionality of the communication server now being recited. The pending claims are directed to the elements that accomplish the procedure of calling

from a communication terminal to a telephone as shown in Figure 11, for example. In particular, the claims describe a communication server that performs communication between a first terminal (communication terminal) and a second terminal (telephone).

In this regard, claim 23 clearly sets forth that the communication server has a first interface that inputs and outputs packet information and a second interface that inputs and outputs non-packet information. In response to receiving a communication request at a first unit of the communication server, a second unit transmits a call setting request to the second terminal. A third unit of the communication server receives a call setting response and a fourth unit transmits a packetized communication accepting response to the first terminal. Finally, a fifth unit establishes communication between the first terminal and the second terminal after the fourth unit has transmitted the packetized communication accepting response. Claim 30 contains similar limitations to the ones mentioned above with respect to claim 23.

Claims 1-4 of the '737 patent fail to disclose the features specifically claimed and recited above. Furthermore, not only has the Examiner failed to disclose where the limitations of the present claims are found in the claims of the '737 patent, the Examiner has also failed to point out why such omissions in the patent would be obvious. In short, Applicants do not believe that the Examiner has made a proper comparison of the pending claims with the claims of the '737 patent in order to support a *prima facie* case for unpatentability based upon double patenting. Therefore, it is

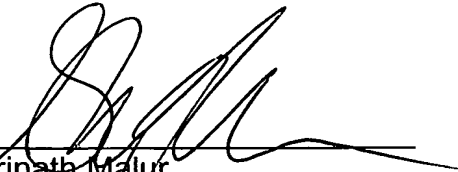
Serial No. 09/836,299

ASA-520-03

requested that prosecution on the merits be reopened and an appropriate office communication presented in due course.

Respectfully submitted,

MATTINGLY, STANGER, MALUR & BRUNDIDGE, P.C.

By 
Shrinath Malur
Reg. No. 34,663
(703) 684-1120

December 28, 2005